

Applicant: A. Wallace et al.
Application No. 10/721,684

REMARKS

This amendment is submitted in response to an Office Action mailed April 4, 2005. Claims 1-69, 71-74, and 76-78 are pending in the present application for the Examiner's review and consideration. Claims 70 and 75 are cancelled without prejudice. The subject matter of claim 70 has been incorporated into the pending claims. Claims 1-69, 71-74, and 76-78 have been amended to more particularly point out and distinctly claim the invention. In view of these claim amendments and the following remarks, reconsideration by the Examiner and allowance of the application are respectfully requested.

CLAIM OBJECTIONS

Claims 1-78 were objected to due to informalities. In particular, the Examiner suggested that the phrase "catalyst system" be changed to "catalyst structure." This phrase has been amended accordingly in the pending claims. The Examiner also noted that the term "aluminium" should be changed to read "aluminum." Also in claims 1 and 46, the phrase "excepting the combination of germanium and lithium only" has been changed to "except for a combination of germanium and lithium," as suggested by the Examiner. Finally, in accordance with the Examiner's suggestion, the applicants have inserted a comma after each different metal when the claim listed three or more different metals.

THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 2-45, 47-67, and 69-78 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons set forth on page 3 of the Office Action. Specifically, the Examiner alleges that there is insufficient antecedent basis for the limitation "the monomer" in claims 2, 47, and 69. Since the Applicants have amended claims 1, 46, and 68 to include the term "monomer", it is believed that this rejection has been overcome. Therefore, the Applicants respectfully request that this rejection be reconsidered and withdrawn.

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THE DOUBLE PATENTING REJECTION UNDER 35 U.S.C. § 101

Claims 1-45 were rejected under 35 U.S.C. § 101 as conflicting with claims 1-45 of U.S. patent application serial No. 10/303,977. Applicants note that according to M.P.E.P. § 804, “A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).” Claim 1 of the present application has been amended so that it is now directed to a catalyst for the polycondensation of polymeric monomers in general. The claim also contains a broader recitation of the forms in which the elements may be present. Specifically, claim 1 recites polycondensation compatible elements, acids, and bases in addition to the other forms.

Because claim 1 of the present application, prior to amendment, encompassed catalyst forms not within the claim scope of Application Serial No. 10/303,977, this rejection of the claims for Statutory Double Patenting under 35 U.S.C. § 101 is improper. Amending the claims so they are directed to catalysts for polyester monomers in general provides an additional line of demarcation to further separate the two groups of claims. The Applicants respectfully request that this rejection be reconsidered and withdrawn.

THE REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103

In the Office Action dated April 4, 2005, the Examiner rejected claims 1-8, 49-52, 68-69, and 75-78 under 35 U.S.C. §§ 102 and 103. However, the Examiner further stated that claims 9-45, 53-67, and 70-72 contained allowable subject matter because “[t]he prior art does not disclose a catalyst containing the claimed metal components having the claimed metal concentrations. There is no motivation to combine the teachings of the references together.” (Office Action at p. 7).

Therefore, to overcome the rejections under 35 U.S.C. §§ 102 and 103, the Applicants have amended claim 1 to incorporate the allowable subject matter of claim 9. In particular, claim 1 was amended to include the metal components and concentrations originally found in claim 9.

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Similarly, independent claim 46 has been amended to incorporate the concentration ranges recited in dependent claims 53 to 55. Likewise, independent claim 68 has been amended to incorporate the concentration ranges recited in dependent claim 70, which has been cancelled.

It is submitted that the amendments to independent claims 1, 46, and 68 better define the subject matter of the invention in a manner that distinguishes claims 1, 46, 68, and their respective dependent claims over the references cited in the April 4, 2005 Office Action, thereby resolving the concerns raised by the Examiner. In particular, claims 1, 46, and 68 now recite metal components and concentrations deemed allowable by the Examiner. Accordingly, the Applicants respectfully request reconsideration of these rejections.

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CONCLUSION

In view of the above claim amendments and remarks, this application is now believed to be in condition for allowance. Reconsideration is, therefore, respectfully requested. However, the Examiner is requested to telephone the undersigned if there are any remaining issues in this application to be resolved.

A one-month Petition for Extension of time to respond to the Office Action is also enclosed with a credit card authorization form for the required fee of \$120.00. Finally, if there are any additional charges in connection with this response, please charge the required fee to Applicants' deposit account number 19-5425.

Respectfully submitted,

Date: July 18, 2005


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